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## REMARKS

The Applicant does not believe that entry of the accompanying response will introduce new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the accompanying response be entered in and that the claims to the present application be, kindly, reconsidered.

The Final Office Action dated April 26, 2004 has been received and considered by the Applicant. Claims 1-22 are pending in the present application for invention. Claims 1-5 and 11-22 stand rejected by the April 26, 2004 Final Office Action. Claims 9-12 and 17 are objected to by the April 26, 2004 Final Office Action.

The Examiner made the April 26, 2004 Final Office Action final based on the assertion that Applicant's amendment necessitated a new ground(s) of rejection. The Applicant hereby asserts the finality of the April 26, 2004 Final Office Action is premature. The MPEP §706.07 details when a Final Rejection is proper on second action.

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)."

The previous amendment submitted March 11, 2004 by the Applicant amended the claims. Claim 3 was broadened by the March 11, 2004 amendment by removing an element. Claim 18 of the present application for invention was added as a new claim including the limitations formerly contained within claim 3. Claim 3 was broadened by the March 11, 2004 amendment to the claims. It should be noted that both Claims 3 and 18 depend from Claim 2. Therefore, Claim 18 as presented by the March 11, 2004 amendment contains exactly the same limitations that were formerly contained within Claim 3. Accordingly, at least pertaining to Claim 18, the holding of finality is premature.

The Applicant, respectfully, requests that the Primary Examiner reconsider the holding of finality of the April 26, 2004 Office Action and that the finality of the April 26, 2004 rejection be withdrawn.

The accompanying response has been made to fully respond to a Final Office

Action, which finality is fully anticipated to be withdrawn because it is premature. The Applicant, therefore, reasonably anticipates an opportunity to respond to a non-final office action.

The Office Action rejects Claims 8, 11 and 12 under the provisions of 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the phrase "particularly a DVR disc" renders Claims 8 and 14 indefinite because it is unclear whether the phrase is part of the claimed invention. This rejection also constitutes a new rejection. The term "particularly a DVR disc" in Claims 8 and 14 was present before the Applicant made the previous response. Accordingly, at least pertaining to Claims 8, 11 and 12, the holding of finality is premature. The Applicant respectfully requests that that the Primary Examiner reconsider the holding of finality of the April 26, 2004 Office Action and that the finality of the April 26, 2004 rejection be withdrawn.

① The Applicant would like to point out that the rejection of Claims 5 and 6 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. constitutes a new rejection that was not necessitated by Applicant's amendment. The previous amendment to Claim 5 simply rearranged the wording in a manner that resulted in no substantive change. The previous amendment to Claim 6 was a broadening amendment that eliminated the recitation of that the number of tracks that are to be skipped is approximately 50. There is no reason that eliminating the recitation of number of that the number of tracks skipped being approximately 50 result in a new rejection using Tsuchiya et al. against Claim 6 in its present form. There is no reason why the combination of Takasago with Tsuchiya et al. could not have been made earlier. The previous amendment had a rejection of Claims 5 and 6 under the provisions of 35 U.S.C. §102(b) as being anticipated by Tsuchiya et al. As previously stated, the previous amendment to Claim 5 does not result in any substantive changes. The previous amendment to Claim 6 simply removed the recitation of the predetermined number of tracks between successive test tracks skipped being approximately 50 and the combination of Takasago with Tsuchiya et al. does not logically result from this previous amendment. The Applicant respectfully requests that that the Primary Examiner reconsider the holding of finality of the April 26, 2004 Office Action and that the finality of the April 26, 2004 rejection be withdrawn.

✓ The Applicant would like to point out that the rejection of Claims 7 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. and further in view of Hosoya constitutes a new rejection that was not necessitated by the previous amendment made by the Applicant. The previous amendment did not change Claim 7 in any manner whatsoever. Claim 7 depends from Claim 5. The previous amendment to Claim 5 rearranged the wording in a manner that resulted in no substantive change. The previous Office Action contained a rejection to Claims 7 under the provisions of 35 U.S.C. §103(a) as being obvious over a Tsuchiya et al. in view of Hosoya. As previously stated, the previous amendment to Claim 5 does not result in any substantive changes. The previous amendment to Claim 5 did not necessitate a new rejection. The Applicant respectfully requests that that the Primary Examiner reconsider the holding of finality of the April 26, 2004 Office Action and that the finality of the April 26, 2004 rejection be withdrawn.

✓ The Applicant would like to point out that the rejection of Claims 8 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. and further in view of Hosoya constitutes a new rejection that was not necessitated by the previous amendment made by the Applicant. The previous amendment did not change Claim 8 did not make any substantive changes. The previous amendment to Claim 5 rearranged the wording in a manner that resulted in no substantive change. The previous Office Action contained a rejection to Claim 8 under the provisions of 35 U.S.C. §103(a) as being obvious over a Tsuchiya et al. in view of Hosoya. As previously stated, the previous amendment to Claim 5 does not result in any substantive changes. The previous amendment to Claim 5 did not necessitate a new rejection. Claim 8 depends from Claim 6. The previous amendment to Claim 6 also did nothing to necessitate the new rejection made by the Final Office Action and the new rejection does nothing to address the changes made to Claim 6. Therefore, the holding of finality is premature. The Applicant respectfully requests that that the Primary Examiner reconsider the holding of finality of the April 26, 2004 Office Action and that the finality of the April 26, 2004 rejection be withdrawn.

✓ The Final Office Action objects to Claims 9-12. The Examiner states that the Claim 9 recites steps of "optionally" entering tracks in an alarm list and storing the alarm list if "applicable". The Examiner further states that Claim 11 contains the phrase "optionally". The Examiner states that the use of the foregoing terms suggest that these

limitations are not necessary. The Applicant respectfully disagrees. The foregoing limitations provide limiting features. Moreover, the same terms were present before the last (non-final) office action. The Examiner previously in a non-final office Action should have addressed the objection discussed above. The Applicant cannot make amendments in response to a final office action as a matter of right. The above-discussed objections constitute new objections that should have been raised earlier. Accordingly, the Applicant respectfully declines to make the suggested changes because there is no guarantee that the amendment would even be entered.

The Final Office Action objects to Claim 17 under the provisions of 35 U.S.C. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner states that Claim 17 is drawn to a recording device and is improperly dependent on Claim 16, drawn to a method. The Examiner further claims that specifying a "control unit" as carrying out a method does not recite what are the actual functions of the "control unit". The Examiner objects to Claim 17 because it is alleged that Claim 17 does not further limit Claim 16. The Applicant, respectfully, disagrees. The additional limitation of a controller being configured to perform the method of Claim 16 does further limit Claim 16. The function of the controller is to perform the method of Claim 16. Therefore, the Applicant declines to amend Claim 17 in view of this objection because the Examiner has not provided a reasonable basis for this requirement.

The Office Action rejects Claims 8, 11 and 12 under the provisions of 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the phrase "particularly a DVR disc" renders Claims 8 and 14 indefinite because it is unclear whether the phrase is part of the claimed invention. The Applicant, respectfully, disagrees. Removal of this phrase would only tend to broaden these claims. However, this rejection constitutes a new rejection and the Applicant can not make an amendment as a matter of right. There is, simply put, no guarantee that the amendment would be entered. Therefore, the Applicant respectfully declines to remove this phrase from Claim 8 and 14. The Applicant, respectfully suggests that this rejection be made in a new, non-final rejection as this rejection is a new rejection that was not

necessitated by any amendment made by the Applicant.

The Office Action rejects Claims 1, 2, 13 and 14 under the provisions of 35 U.S.C. § 102(b) as anticipated by Takasago, et al. (hereinafter referred to as Takasago).

Regarding Claim 1, the Examiner states that Takasago discloses in FIG. 1 the examining of a record carrier for the presence of a defect. The Applicant would like to respectfully point out that the disclosure of Takasago relates to the determining of an off track situation and that a defect in the optical disc is only one of the purposes addressed by the off track detection of Takasago (see column 3, lines 28-60). Therefore, while the title of Takasago states defect detection, the disclosure of Takasago only details techniques that are related to off track detection. The rating of the track in the present invention done for the purpose of determining if there is a defect in the track. There is no rating of a track for a defect within the disclosure of Takasago. Takasago examines the track signal to determine if there is an off track situation which could be the result of a vibration (see column 3, lines 1-6). Takasago never rates the track itself. Accordingly, the rejection to Claim 1 is respectfully traversed.

Regarding Claim 2, the Examiner states that Takasago discloses that the track is determined as being defective if the absolute value of the tracking signal exceeds a predetermined threshold at column 5, line 47 to column 6, line 14. The Applicant respectfully points out that this cited portion of Takasago discusses tracking errors that are determined by application of a tracking signal to a pair of comparators. The tracking signal can be determined as the light spot to be tracking sufficiently near the center of the track resulting in each comparator yielding a logical "0" which is interpreted as being proper tracking. The tracking signal can be determined as the light spot to be not sufficiently near the center of the track resulting in one of the comparators yielding a logical "1" which is interpreted as not tracking properly. Or, the tracking signal can be determined as the light spot being off track resulting in multiple logical "1" pulses. There is no disclosure, or suggestion, within Takasago for rating a track as being defective as stated by the Examiner in the Final Office Action. Moreover, there is no disclosure, or suggestion, within Takasago for determining that a track is defective if the absolute value that the tracking signal is great than a predetermined threshold. Simply put, Takasago determines if the light spot is on track or off track; not whether the track is defective or not. Accordingly this rejection is, respectfully, traversed.

Regarding Claim 13, the Examiner states that Takasago discloses at column 7,

lines 6-19 whether the recording process should be continued or discontinued based on the tracking signal. The Applicant respectfully points out that column 7, lines 6-19 of Takasago again teaches actions based on whether the light spot is on track or off track.

Regarding Claim 14, the Examiner states that Takasago discloses at column 5, line 47 - column 6, line 14 teaches that the recording is discontinued if the tracking signal exceeds a predetermined value for a predetermined period of time. The Applicant would like to point out that this is an incorrect reading of Takasago at column 5, line 47 - column 6, line 14. Takasago at column 5, line 47 - column 6, line 14 teaches that if the tracking signal reaches a certain level indicating that tracking signal is off track that multiple logical "1" pulses will be emitted and the additional time duration of the additional logical "1" pulses is then interpreted as being off track to discontinue recording as stated at column 7, lines 6-19. Claim 14 to the present invention recites that if the tracking signal itself exceeds a predetermined value and for a predetermined time then the recording process is discontinued. There is no disclosure or suggestion within Takasago that the tracking sign exceeding a predetermined value for a predetermined time results in the discontinuing of recording. Accordingly this rejection is, respectfully, traversed.

The Office Action rejects Claims 3, 4, 15, 16, 18, 19, 21, and 22 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago applied to claims 2 and 14 above.

Regarding Claims <sup>✓</sup>3, <sup>✓</sup>15, <sup>✓</sup>18 and <sup>✓</sup>21, the Examiner states that Takasago discloses at column 5, lines 49 - 51 a tracking signal having a nominal value of zero, that the tracking signal has a maximum value and a level of a preselected fraction of the maximum value chosen as the predetermined signal threshold. The Examiner then asserts that Takasago is silent regarding whether the maximum value corresponds to the maximum level deviation with respect to set of the track. The Applicant respectfully disagrees. Takasago is not silent regarding a maximum lateral deviation with respect to the center of the track. Takasago discusses the situation where the light spot actually digresses from the track (which corresponds to the maximum lateral deviation) resulting in a signal above the range as a signal portion wherein two pulses are formed by the outputs of comparator 17 and 18 (see column 5, line 47 to column 6, line 14). Therefore, Takasago discusses maximum lateral deviation occurring when the light spot is no longer in the track. Furthermore, Takasago clearly discusses that maximum lateral deviations will be

represented by multiple pulses. The present invention defines the tracking error parameter on page 10 of the specification as being  $|S|/S_{max}$  where  $S_{max}$  is the largest value for the tracking signal indicative of the greatest lateral deviation from the center of the track, and  $|S|$  is the absolute value of the received tracking signal. Takasago clearly discusses that the maximum lateral deviation occurs when the light spot is no longer within the track. There is no disclosure or suggestion within Takasago for taking any fractional portion of the tracking signal value that occurs at the maximum lateral deviation from the center of the track (which is clearly outside the track) and using that fractional portion as a threshold. Accordingly, this rejection of Claims 3, 15, 18 and 21 is respectfully traversed.

The Applicant would like to respectfully point out that the above discussed this rejection of Claims (3, 15, 18 and 21) is a new rejection that was not necessitated by the previous amendment made by the Applicant. The elements addressed in this rejection were present prior the last amendment made by the Applicant. For example, Claim 18 is identical to Claim 3 regarding Claims 3.

Regarding Claims 4, 16, 19 and 22, the Examiner states that Takasago does not disclose the recited predetermined time. Wine and arrange between 50  $\mu$ s and 75  $\mu$ s.

Furthermore, regarding claims in 19 and 22, the Examiner states that Takasago does not disclose that the recited period of time is approximately 60  $\mu$ s. The Final Office Action does not contend that Takasago suggests implementing any of the foregoing time periods. The Examiner has made the assertion that would have been obvious for a person of ordinary skill in the art of to choose any of the selected time periods because the Applicant has not disclosed any advantage, particular purpose or solving of any stated problem. The Applicant would like to, respectfully, point out that the Examiner has not employed a proper obviousness analysis. In order to determine obviousness there must be some suggestion of motivation of the prior art to make the modification done by the Examiner in the Final Office Action. The Examiner has not advanced any authority to support the assertion made in the Final Office Action that the foregoing rationale is a proper rationale for determining obviousness.

The MPEP at §2143 states that to "establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Applicant respectfully points out that the Final Office Action does not satisfy any of the three foregoing criteria and therefore has not made a *prima and facie* case of obviousness. Moreover, the motivation to make the modification suggested by the Examiner must be found within the prior art reference, and the Examiner has in fact stated that is not found within Takasago. Additionally, there is no reason to attempt to modify the teachings of Takasago to arrive at the present invention has recited by the rejected claims because Takasago pertains to correcting tracking errors. Takasago does not pertain to identifying defective areas on a disk. For the foregoing reasons, this rejection is respectfully traversed.

The Office Action rejects Claims 5 and 6 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. (JP 01253638 A). The Examiner states that Takasago does not disclose the steps of a) examining the integrity of predetermined test tracts of the record carrier, b) examining the integrity of tracts adjacent the relevant test track each time that upon the examination of the test track it appears to be defective, in order to determine this way the number of tracts affected by the same spot defect, c) entering the relevant tracts in a defect list each time that the number thus determined in step (b) is greater than a predetermined threshold value, and d) storing the defect list into a memory. The Examiner further states that Tsuchiya et al. teach the foregoing steps. The Applicant would like to point out that Tsuchiya et al. teach use a reference value WC that is set to have the magnitude of defect smaller than a normal checking reference. The defects detected are from a regenerated signal RF, the tracking error signal TE and a focused error signal FE in one track are checked. Tsuchiya et al. teach the recording of each defect that exceeds the reference value WC within a memory and then read out that the contents of the memory, which includes each individual defect. The Applicant respectfully points out that this is not what is recited by the rejected claims. Step c) recites entering the relevant tracts to any defect list each time that the number thus determined in step (b) is greater than a predetermined threshold value. Tsuchiya et al. teach

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\* recording of each individual defect within a track. There is no suggestion or disclosure within  
\* Tsuchiya et al. for providing a threshold value to determine the number of tracks that are affected  
\* by the same spot defect and only recording those defects that are at least as large as the  
threshold.

Regarding Claim 6, Claim 6 depends from Claim 5 which is previously discussed is believed to be allowable, therefore, Claim 6 is also believed to be allowable.

The Applicant would like to point out that the rejection of Claims 5 and 6 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. is a new rejection that was not necessitated by the previous amendment made by the Applicant. The previous amendment to Claim 5 simply rearranged the wording in a manner that resulted in no substantive change. The previous amendment to Claim 6 was a broadening amendment that eliminated the recitation of the number of track as to be skipped as being approximately 50. There is no reason to cite Tsuchiya et al. against Claim 6 in its present form for not reciting that the number of tracks skipped is approximately 50. There is no reason why the combination of Takasago with Tsuchiya et al. could not have been made earlier. The previous amendment had a rejection of Claims 5 and 6 under the provisions of 35 U.S.C. §102(b) as being anticipated by Tsuchiya et al. As previously stated, the previous amendment to Claim 5 does not result in any substantive changes. The previous amendment to Claim 6 simply removed the recitation of the predetermined number of tracks between successive test tracks skipped being approximately 50 and the combination of Takasago with Tsuchiya et al. does not logically result from this previous amendment.

The Final Office Action rejects Claims 7 and 8 under the provisions of 35 U.S.C. §103(a) as being unpatentable over the combination of Takasago with Tsuchiya et al. and further in view of U.S. Patent No. 4,821,521 issued to Hosoya (hereinafter referred to as Hosoya).

As previously discussed the combination of Takasago with Tsuchiya et al. teaches recording of each individual defect within a track. There is no suggestion or disclosure within Tsuchiya et al. for providing a threshold value to determine the number of tracks that are affected by the same spot defect in only recording those defects that are at least as large as the threshold. Accordingly, the rejection of Claim 5, as previously discussed, is in error. The addition of Hosoya to the combination of Takasago and Tsuchiya et al. does nothing to correct this error. Hosoya at column 6, lines 22-25 discloses storing defective sector information in the

optical disk. The Applicant respectfully points out that Claim 7 includes all the features of Claim 5 and that the defect list as recited by Claim 5 only includes tracts affected by the same spot defect wherein the number of tracts is greater than a predetermined threshold. The cited references, either alone or taken in combination, do not disclose or suggest the foregoing features of creating a defect list as recited by Claim 5 that includes tracts affected by the same spot defect wherein the number of tracts is greater than a predetermined threshold. Accordingly this rejection is, respectfully, traversed.

The Applicant would like to point out that the rejection of Claims 7 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. and further in view of Hosoya is a new rejection that was not necessitated by the previous amendment made by the Applicant. The previous amendment did not change Claim 7 in any manner whatsoever. The previous amendment to Claim 5 rearranged the wording in a manner that resulted in no substantive change. The previous Office Action contained a rejection to Claims 7 under the provisions of 35 U.S.C. §103(a) as being obvious over a Tsuchiya et al. in view of Hosoya. As previously stated, the previous amendment to Claim 5 does not result in any substantive changes. The previous amendment to Claim 5 did not necessitate a new rejection. Claim 7 depends from Claim 5 and claim 7 was not amended by Applicant's previous response. Therefore, the holding of finality for this Office Action is premature.

Regarding the rejection to Claim 8 under the provisions of 35 U.S.C. §103(a) as being unpatentable over the combination of Takasago with Tsuchiya et al. and further in view of Hosoya. As previously discussed the combination of Takasago with Tsuchiya et al. disclose recording of each individual defect within a track. There is no suggestion or disclosure within Tsuchiya et al. for providing a threshold value to determine the number of tracks that are affected by the same spot defect in only recording those defects that are at least as large as the threshold. Accordingly, the rejection of Claim 5, as previously discussed, is in error. Claim 6 depends from Claim 5 and Claim 8 depends from Claim 6. The addition of Hosoya to the combination of Takasago and Tsuchiya et al. does nothing to correct this error. Hosoya at column 2, lines 64-68 and FIG. 7 teaches referring to defective sector information in the optical disk. The Applicant respectfully points out that Claim 8 includes all the features of Claim 5 and that the defect list as recited by Claim 5 only includes tracts affected by the same spot defect wherein the number of tracts is greater than a predetermined threshold. The cited references,

either alone or taken in combination, do not disclose or suggest the foregoing features of creating a defect list as recited by Claim 5 that includes tracts affected by the same spot defect wherein the number of tracts is greater than a predetermined threshold. Accordingly this rejection is, respectfully, traversed.

The Applicant would like to point out that the rejection of Claims 8 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. and further in view of Hosoya is a new rejection that was not necessitated by the previous amendment made by the Applicant. The previous amendment did not change Claim 8 did not make any substantive changes. The previous amendment to Claim 5 rearranged the wording in a manner that resulted in no substantive change. The previous Office Action contained a rejection to Claim 8 under the provisions of 35 U.S.C. §103(a) as being obvious over a Tsuchiya et al. in view of Hosoya. As previously stated, the previous amendment to Claim 5 does not result in any substantive changes. The previous amendment to Claim 5 did not necessitate a new rejection. Claim 8 depends from Claim 6. The previous amendment to Claim 6 also did nothing to necessitate the new rejection made by the Final Office Action and the new rejection does nothing to address the changes made to Claim 6. Therefore, the holding of finality is premature.

The Final Office Action rejects Claim 20 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Takasago in view of Tsuchiya et al. The Applicant, respectfully points out that there is no suggestion or disclosure within Tsuchiya et al. for providing a threshold value to determine the number of tracks that are affected by the same spot defect in only recording those defects that are at least as large as the threshold as recited by Claim 5. Accordingly, the rejection of Claim 5, as previously discussed, is believed to be in error. Claim 20 depends from Claim 5; therefore, Claim 20 is also believed to be allowable.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

By 

James D. Leimbach, Reg. 34,374  
Patent Attorney (585) 381-9983

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